



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER OF PATENTS AND TRADEMARKS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/017,578	12/14/2001	Stephen M. Brinkman	B-0114.07	6140

7590

05/29/2003

LAW OFFICES OF CHRISTOPHER L. MAKAY
1634 Milam Building
115 East Travis Street
San Antonio, TX 78205

EXAMINER

HAYES, BRET C

ART UNIT

PAPER NUMBER

3644

DATE MAILED: 05/29/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application N .

10/017,578

Applicant(s)

BRINKMAN, STEPHEN M.

Examiner

Bret C Hayes

Art Unit

3644

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 23 April 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-41 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-41 is/are rejected.
- 7) ☒ Claim(s) 2,10,12,21 and 22 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☒ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 7,8.
- 4) ☐ Interview Summary (PTO-413) Paper No(s) _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

DETAILED ACTION

Allowable Subject Matter

1. The indicated allowability of claims 1 – 41 is withdrawn in view of the newly discovered reference(s) to US Patent Nos. 2,663,964 to Martin ('964), 2,770,063 to Martin ('063) and 4,771,567 to Cannon ('567). Rejections based on the newly cited reference(s) follow. Due to the newly based rejections of the claims, the finality of the previous Office Action, Paper No. 6, is hereby withdrawn.

Claim Objections

2. Claims 2, 10, 12, 21 and 22 are objected to because of the following informalities.

3. It has been held that the recitation that an element is “adapted to” perform a function is not a positive limitation but only requires the ability to so perform. It does not constitute a limitation in any patentable sense. *In re Hutchinson*, 69 USPQ 138. Appropriate correction is required.

4. It has been held that the functional “whereby” statement does not define any structure and accordingly cannot serve to distinguish. *In re Mason*, 114 USPQ 127, 44 CCPA 937 (1957).

Claim Rejections - 35 USC § 112

5. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter, which the applicant regards as his invention.

6. Claims 37 and 38 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Art Unit: 3644

7. Claims 37 recites, “securing a lure 10 to a hook 51 (et al) with a fishing line 70 attached thereto; selecting a lure manipulator 56 (et al) dependent upon fishing conditions,” and, “securing the lure manipulator 56 (et al) to the hook 51 and to the lure 10.” This is unclear because according to the disclosure every instance of a lure manipulator includes the hook integrally in the embodiment; so that there appears to be no way that these two elements become separated allowing for the “securing of the lure manipulator to the hook.”

8. Re – claim 38, any claim dependent upon a rejected base claim is also rejected.

Claim Rejections - 35 USC § 102 & 103

9. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

10. Claims 1 and 6 rejected under 35 U.S.C. 102(b) as being anticipated by Martin ('063).

11. '063 discloses the claimed invention including: (claim 1) a fish catching system, comprising: a hook 16 including a barb and a shaft 17 terminating in an eyelet 19 that receives a fishing line 20, and a lure manipulator 1 – 3 slidably mounted on the shaft 17; and (claim 6) wherein the lure manipulator 1 – 3 comprises a lure retainer 12 coupled with a head 1.

12. Claims 25 and 27 rejected under 35 U.S.C. 102(b) as being anticipated by Martin ('964).

13. '964 discloses the claimed invention including: (claim 25) a lure 1 comprising a body 4, and a tail 3 including an aperture 9 that receives a hook or fishing line 8 therethrough; and (claim 27) wherein the aperture 9 facilitates movement of the tail 3 along the hook or fishing line 8, thereby simulating game fish prey motion.

Art Unit: 3644

14. Claims 33 – 35 are rejected under 35 U.S.C. 102(b) as being anticipated by Cannon ('567).

15. '567 discloses the claimed invention including: (claim 33) a fishing lure **10** comprising a body **20** and a barb guard, as set forth in col. 3, line 4; (claim 34) further comprising a tail **26**; and (claim 35) wherein the tail **26** includes a tail fan, see Fig. 2, for example.

16. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

17. Claims 37 and 38 are rejected under 35 U.S.C. 102(b) as being anticipated by either, Martin ('964) or Martin ('063), or, in the alternative, under 35 U.S.C. 103(a) as being unpatentable over either Martin ('964) or Martin ('063) -- the rejection under 35 U.S.C. 112 above notwithstanding.

18. '964 and, alternatively, '063, disclose a method of fishing comprising: (claim 37) securing a lure **1**, or **1 – 3**, to a hook **7**, or **16**, with a fishing line **8**, or **20**, thereto; selecting a lure manipulator; securing the lure manipulator to the hook and to the lure; placing the lure in a first position, Figs. 1 in both; and casting the lure into a body of water; and (claim 38) pulling the fishing line to move the hook through the lure manipulator and place the lure in a second position, Figs. 2 and 3, respectively; and releasing the fishing line to return the hook through the lure manipulator and place the lure in the first position.

19. While neither '964 nor '063 disclose the hook actually going through the lure manipulator, '063 does disclose a rigid shaft **17** connected to a hook **16**. Since the hook in the

Art Unit: 3644

disclosure includes a rigid shaft portion, it would have been obvious to one having ordinary skill in the art at the time the invention was made to use this portion of the shaft to pass through the lure manipulator, since it has been held that rearranging parts of an invention involves only routine skill in the art. *In re Japiske*, 86 USPQ 70. Further, it would have been obvious to one having ordinary skill in the art at the time the invention was made to combine the rigid shaft 17 with the shaft portion of the hook 16, since it has been held that forming in one piece an article which has formerly been formed in two pieces and put together involves only routine skill in the art. *Howard v. Detroit Stove Works*, 150 U.S. 164 (1983).

20. Claims 2 – 5 and 7 – 10 are rejected under 35 U.S.C. 103(a) as being unpatentable over Martin ('063), as applied to claim 1 above.

21. '063 discloses the invention substantially as claimed, except for: (claim 2) pulling the fishing line moves the shaft of the hook through the lure manipulator; (claim 3) the lure manipulator comprising a sleeve; (claim 4) the lure manipulator comprising a sleeve with a weight attached thereto; (claim 5) the lure manipulator comprising a sleeve including a post attached thereto; (claim 7) the lure manipulator being hollow so as to receive a noise maker therein; (claim 8) a collar coupled with the shaft to stop forward movement of the lure manipulator; (claim 9) a spring mounted on the shaft between the collar and the lure manipulator; and (claim 10) the lure manipulator including a slot adapted to receive the shaft therein, whereby constriction of the lure manipulator closes the slot and secures the lure manipulator about the shaft.

22. Re – claim 2, see the rejection of claim 37 and 38 above, and particularly paragraph 19.

Art Unit: 3644

23. Re – claim 3, the addition of a sleeve to the lure manipulator would be obviated by the aperture **18** of '063, since it is well known in the analogous art of guiding shafts through apertures to use sleeves, i.e., wear items such as bushings, for the purpose of limiting the wear on the aperture itself.

24. Re – claim 4, '063 discloses the claimed invention, as applied to claim 3 above, including a weight **21**, except for the weight being attached to the sleeve. It would have been obvious to one having ordinary skill in the art at the time the invention was made to attach the weight to the sleeve, since this would involve merely rearranging the parts of the invention and since it has been held that rearranging parts of an invention involves only routine skill in the art. *In re Japiske*, 86 USPQ 70.

25. Re – claim 5, '063 discloses a post **12** attached to the manipulator. It would have been obvious to one having ordinary skill in the art at the time the invention was made to attach the post to the sleeve, since this would involve merely rearranging the parts of the invention and since it has been held that rearranging parts of an invention involves only routine skill in the art. *In re Japiske*, 86 USPQ 70.

26. Re – claim 7, it would have been obvious to one having ordinary skill in the art at the time the invention was made to include a noise maker in the body, since it was known in the art that noise making devices are generally used to attract fish and that these devices are most often contained within the body of the lure itself.

27. Re – claim 8, it would have been obvious to one having ordinary skill in the art at the time the invention was made to include a stop collar on the shaft to stop the forward movement of the lure manipulator, since stop collars are well known in the analogous art of guiding shafts

Art Unit: 3644

through apertures, as stated above in paragraph 20, for the purpose of limiting the movement of either the shaft or an item moving on the shaft.

28. Re – claim 9, '063 discloses a spring 8. It would have been obvious to one having ordinary skill in the art at the time the invention was made to mount the spring on the shaft between the collar and the lure manipulator, since this would involve merely rearranging the parts of the invention and since it has been held that rearranging parts of an invention involves only routine skill in the art. *In re Japiske*, 86 USPQ 70.

29. Re – claim 10, it would have been obvious to one having ordinary skill in the art at the time the invention was made to have the lure manipulator include a slot, since it was known in the art that sinkers generally include a slot, whereby constriction of the sinker closes the slot, and thus, it would have been obvious to make the lure manipulator using the same type of construction.

30. Claims 12 – 22 and 24 are rejected under 35 U.S.C. § 103 as being unpatentable over Martin ('063).

31. Re – claim 12, see paragraph 29 above.

32. Re – claim 13, '063 discloses the claimed invention except for the system comprising a plurality of lure manipulators. It would have been obvious to one having ordinary skill in the art at the time the invention was made to provide a plurality of manipulators, since it has been held that mere duplication of the essential working parts of a device involves only routine skill in the art. *St. Regis Paper Co. v. Bemis Co.*, 193 USPQ 8.

33. Re – claim 14, '063 discloses the claimed invention, as applied to claims 12 and 13 above, except for the plurality of manipulators each having a different weight. It would have

Art Unit: 3644

been obvious to one having ordinary skill in the art at the time the invention was made to provide each manipulator with a different weight, since it has been held that where the general conditions of a claim are disclosed in the prior art, discovering the optimum or workable ranges involves only routine skill in the art. *In re Aller*, 105 USPQ 233.

34. Re – claim 15, it would have been obvious to one having ordinary skill in the art at the time the invention was made to change the shape of the manipulator, since there is no invention in merely changing the shape or form of an article without changing its function except in a design patent. *Eskimo Pie Corp. v. Levous et al.*, 3 USPQ 23.

35. Re – claim 16, it would have been an obvious matter of design choice to change the size of the manipulators, since a change in size is generally recognized as being within the level of ordinary skill in the art. *In re Rose*, 105 USPQ 237 (CCPA 1955).

36. Re – claim 17, see paragraph 26 above as applied to claim 7.

37. Re – claims 18 – 20, see paragraphs 23 – 25 as applied to claims 3 – 5 above.

38. Re – claim 21, '063 discloses the claimed invention except for the head residing underneath the lure. It would have been obvious to one having ordinary skill in the art at the time the invention was made to so arrange the device, since it has been held that rearranging parts of an invention involves only routine skill in the art. *In re Japiske*, 86 USPQ 70.

39. Re – claim 22, '063 discloses the claimed invention as applied to claim 12 above.

40. Re – claim 24, '063 discloses the claimed invention as applied to claim 12 above, except for the eyelet of the shaft of the hook 16 receiving a fishing line. '063 discloses the eyelet 19 of the shaft 17 receiving a fishing line 20, which is connected to the hook 16. It would have been obvious to one having ordinary skill in the art at the time the invention was made to arrange the

Art Unit: 3644

eyelet of the shaft of the hook to receive the fishing line, since it has been held that rearranging parts of an invention involves only routine skill in the art. *In re Japiske*, 86 USPQ 70.

41. Claims 26, 28, 30 and 39 are rejected under 35 U.S.C. § 103 as being unpatentable over Martin '964, as applied to claim 25 above.

42. Re – claim 26, '964 discloses the claimed invention, including a weight 10, except for the tail being weighted. It would have been obvious to one having ordinary skill in the art at the time the invention was made to arrange the tail of the lure to be weighted, since it has been held that rearranging parts of an invention involves only routine skill in the art. *In re Japiske*, 86 USPQ 70.

43. Re – claim 28, '964 discloses the claimed invention except for the tail being removably attached to the body. It would have been obvious to one having ordinary skill in the art at the time the invention was made to have the tail be removably attached to the body, since it has been held that constructing a formerly integral structure in various elements involves only routine skill in the art. *Nerwin v. Erlichman*, 168 USPQ 177, 179.

44. Re – claim 30, '964 discloses the claimed invention except for a sleeve coupled with the tail. The addition of a sleeve to the lure would be obviated by the aperture 9 of '964, since it is well known in the analogous art of guiding shafts through apertures to use sleeves, i.e., wear items such as bushings, for the purpose of limiting the wear on the aperture itself.

45. Re – claim 39, '964 discloses the claimed invention except for the tail 3 moving, arguably completely, underneath the body 4. However, it would have been obvious to one having ordinary skill in the art at the time the invention was made to have the tail move completely underneath the body, since it has been held that where the general conditions of a

Art Unit: 3644

claim are disclosed in the prior art, discovering the optimum or workable ranges involves only routine skill in the art. *In re Aller*, 105 USPQ 233.

46. Claims 11 and 23 are rejected under 35 U.S.C. § 103 as being unpatentable over Martin ('063) in view of 4,771,567 to Cannon ('567).

47. '063 discloses the invention substantially as claimed. However, '063 does not disclose the lure including a barb guard.

48. '567 teaches guarding a barb 61 with a lure 20 in the same field of endeavor for the purpose of preventing snagging, as set forth in col. 3, line 4.

49. It would have been obvious to one having ordinary skill in the art at the time the invention was made to modify '063 to include a barb guard as taught by '567 in order to prevent snagging.

50. Claim 29 is rejected under 35 U.S.C. § 103 as being unpatentable over Martin ('964) in view of Cannon ('567).

51. '964 discloses the invention substantially as claimed. However, '964 does not disclose the lure including a barb guard.

52. '567 teaches guarding a barb 61 with a lure 20 in the same field of endeavor for the purpose of preventing snagging, as set forth in col. 3, line 4.

53. It would have been obvious to one having ordinary skill in the art at the time the invention was made to modify '964 to include a barb guard as taught by '567 in order to prevent snagging.

54. Claim 36 is rejected under 35 U.S.C. § 103 as being unpatentable over Cannon ('567).

55. '567 discloses the invention substantially as claimed as applied to claim 33 – 35 above.

Art Unit: 3644

56. However, '567 does not disclose the body including eyes, antennae, and claws.

57. It is common knowledge in the prior art to make fishing lures appear as life-like as possible, i.e., to include eyes, antennae and claws, in the same field of endeavor for the purpose of the lure being more attractive to fish.

58. It would have been obvious to one having ordinary skill in the art at the time the invention was made to include eyes, antennae and claws in order to make the lure appear to be life-like.

59. Claims 40 and 41 are rejected under 35 U.S.C. § 103 as being unpatentable over either Martin ('063) or Martin ('964), as applied to the claims above.

60. Both '063 and '964 disclose the invention substantially as claimed. However, neither discloses the use of a sleeve passing through the tail for passing the fishing line through.

61. The addition of a sleeve to the lure manipulator would be obviated by either the aperture 18 of '063, or the aperture 9 of '964, since it is well known in the analogous art of guiding shafts through apertures to use sleeves, i.e., wear items such as bushings, for the purpose of limiting the wear on the aperture itself.

Conclusion


Any inquiry concerning this communication should be directed to Bret Hayes at telephone number (703) 306-0553. The examiner can normally be reached Monday through Friday from 6:00 am to 6:30 pm, Eastern Standard Time.

Art Unit: 3644

If attempts to contact the examiner by telephone are unsuccessful, the examiner's supervisor, Charles Jordan, can be reached at (703) 306-4159. The fax number for this group is (703) 305-7687.

bh

5/24/03


CHARLES T. JORDAN
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 3600